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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,129	09/23/2003	Wei Yen	57159-8008.US01	2562
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PERKINS COIE LLP P.O. BOX 2168 MENLO PARK, CA 94026			EXAMINER BOND, CHRISTOPHER H	
			ART UNIT	PAPER NUMBER
			3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/670,129

Applicant(s)

YEN ET AL.

Examiner

Christopher H. Bond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09/23/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/2/2005, 12/5/2005
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Information Disclosure Statement*

1. The Information Disclosure Statements filed on June 2, 2005 and December 5, 2005 have been acknowledged.

### *Claim Objections*

2. Claim 3 is objected to because of the following informalities: 'the software' lacks antecedent basis. It is however understood by the examiner what is meant by the applicant, and the claim will be examined on the merits. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. **Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
5. The examiner believes the applicant is submitting a design claim, in which case, a separate application must be filed for a design patent.
6. Because of the indefiniteness and ambiguity of this claim, the claim is not even being examined on the merits.

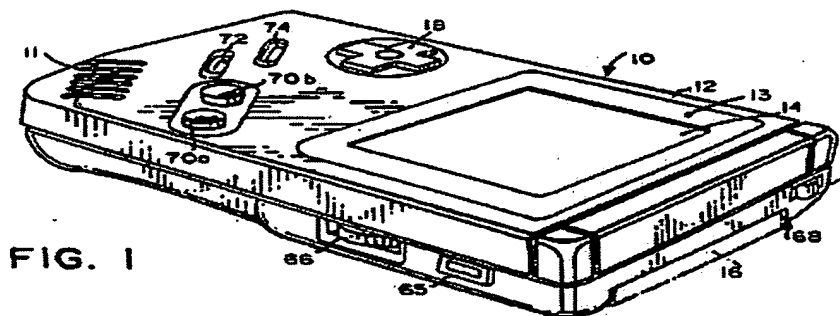
***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Okada et al., USPAT 5,184,830 (Okada)**

9. As to claim 1, Okada discloses (abstract), "A hand-held electronic game machine for use with attachable/detachable memory game packs...wherein the game machine can be connected with others for simultaneous multiple player competition.



Okada further discloses (column 3, lines 1-51), "FIG. 1 is a perspective view showing the exterior housing of an exemplary hand-held liquid crystal game machine...This hand-held liquid crystal game machine...10 includes a- case 12 which is provided with an LCD panel 14...On a rear lower surface of the case 12, [is] an insertion port 68...An external ROM cartridge 16 is pluggably inserted in the insertion port 68...Thus, the external ROM cartridge 16 can be attachably/detachably connected to the game machine 10...The cross-key switch 18 has four direction designating portions and, by

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depressing any one of the same, it is possible to move the game character upward or downward or leftward or rightward....In addition...two push-button switches **70a** and **70b** are provided on the upper surface of the case...to control the game character being displayed on the LCD panel..." (This anticipates the applicant's limitation of having a system including an integrated element combining the capabilities of a console and controller being included in a housing and being hand-held, with the housing including a location capable of receiving a cartridge, the cartridge being capable of being inserted and removed.

10. As to claim 16-18, in addition to what is discussed above and incorporated herein, the key-switch and buttons serve as the input device, capable of controlling the game character—where the game software is contained on the external ROM cartridge. Okada discloses (column 13, lines 32-40), "...processing means, coupled to said removable external memory and said memory means, for executing said game program stored in said external memory for controlling the display of moving objects on said display screen of said dot-matrix liquid crystal display in response to the actuation of said first and second game control switches and for controlling the display of background characters on said display screen." Okada further discloses (column 10, lines 41-58). In addition, preferably, if inconsistency is detected in either one of the two comparison steps...the CPU core...executes the inhibiting process...In other words...if the first and second character data are no coincident with each other, the LCD panel...is wholly turned on or off or flashed, whereby the operator or user is notified that the external ROM cartridge which is loaded at that time is not an authorized one...since

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the second character has been displayed [from the external ROM to the character RAM], the operator or user will know the reason is that the external ROM cartridge is an unauthorized cartridge" (This anticipates the applicant's limitation of having a system with an input device, a memory including software (external ROM game) capable of receiving inputs from at least one device, software capable of generating a signal capable of being communicated to an output device, with a secure processing capable of executing or interpreting instruction in the software, controlling the operation of the software, and recognizing if software is authorized software, where the cartridge includes memory, and the cartridge includes at least some information capable of authenticating the software.).

11. Accordingly, claims 16, 17, and 18 are anticipated.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 2 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Okada, USPAT 5,426,763 (Okada2).**

14. Okada2 discloses (abstract), "A memory cartridge which may be loaded in an attachable/detachable manner to a data processing apparatus, such as a hand-held electronic game machine having a central processing unit (CPU), includes logic control

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circuitry, a program read only memory (ROM), a bank changing circuit, and external random access memory (RAM)...When the first key data is read from the program ROM and the reset signal is detected, the external RAM may be accessed by the CPU to read and write information from/into the external RAM" (this is equivalent to the applicant's limitation of the cartridge including some rewritable memory elements, and having a cartridge that includes at least some information—i.e. program ROM—that's capable of replacing or upgrading the software (i.e. writing information to the external RAM)). It is well known in the art, that this type of cartridge is used in the game machine discussed above, and that game information can be saved on this game cartridge's memory.

15. Accordingly, claims 2 and 19 would have been at least obvious.

16. **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Sawano et al., USPAT 6,544,126 (Sawano).**

17. While Okada discloses a game system with removable game cartridges, he however fails to disclose a game system with software that can be dynamically replaced or upgraded.

18. Sawano discloses (abstract), "A portable handheld game machine includes a capability to download and execute code from a source such as another game machine. The portable game machine enters a download mode in which it is receptive to receipt of executable code downloaded from the source." Sawano further discloses (column 2, lines 31-36), "When operating in the "download mode", the portable game machine is capable of receiving executable code written to it by a data source (e.g., another

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portable game machine, a home video game machine, a personal computer, a network, etc.) The portable game machine writes the received executable code into an internal working random access memory and then proceeds to execute the code.”

19. The advantage of using software that can be replaced, upgraded or updated from another source, Sawano writes (column 2, lines 37-41), is that, “...this download capability permits multiple players to play a common video game on multiple video game units using only a single cartridge or other storage media.”

20. This is evidence that one of ordinary skill in the art would find a reason/motivation/suggestion to use a game system where the software can be replaced or upgraded—i.e. downloaded—to allow multiple players to play a common video game on multiple video game units using only a single cartridge.

21. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Okada with the downloadable software capabilities as described by Sawano for the purpose of allowing players to play a common video game on multiple video game units using only a single cartridge or other storage media.

**22. Claims 4-6 and 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Tomizawa et al., USPAT 6,500,070 (Tomizawa).**

23. What is disclosed in Okada is discussed above and incorporated herein.



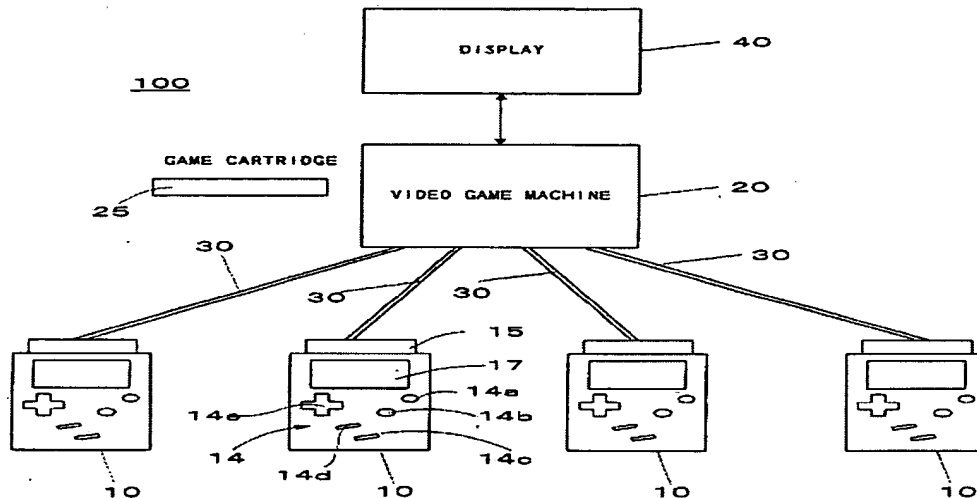
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24. While Okada discloses a game system, he fails to explicitly disclose a communication link, and software capable of supporting interaction between the integrated element and a remote game console.

25. As to claims 4-6, 8, and 11-15, Tomizawa discloses (abstract), "A combined game system [including] a plurality of portable game machines [10] and a video game machine [20]. The portable game machines are connected to the video game machine through communication cables [30], and the video game machine is in turn connected to a display [40]. Each portable game machine has an LCD and an operating device to process a unit according to key input information to the operating device and a program of portable game. The LCD displays a discrete picture based on the unit information (i.e. software). Simultaneously, the unit information is transmitted to the video game machine. The video game machine processes the unit information based on which a common picture is displayed on the display." Tomizawa further discloses (column 1, line 61-column 2, line 2), "...transmitting receiving means from the transmitting and receiving the unit information to and from the video game machine (console)...temporary storage means for temporarily storing unit information transmitted to and from the portable game machine through the connection..." (This is equivalent to the applicant's limitations of having a system with a communication link to a general purpose computing device with the software supporting interaction between a remote game console and the portable game device (integrated element), where the communication link includes audio or video output from the portable game device to an output device (console and display), and where the communication link includes input

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from the console to the portable game device, and where the software includes at least one element supporting a game with multiple consoles (i.e. interactive game between portable game devices with common display), and having a system with a communication link to at least one supplemental console, the communication link being capable of supporting communication between the supplemental console (video game machine) and an output device (display) or integrated element (portable game machine)).



26. The advantage of having a game system of portable game machines and a game console, Tomizawa writes (column 1, lines 11-17), is that it allows for a plurality of portable game systems to be connected to a game console in connection with a display, thereby enabling a common interactive game to play on these portable and video game machines.

27. This is evidence that one of ordinary skill in the art would find a reason/motivation/suggestion to have a game system with portable game systems

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connected to a game console with both a common and discrete displays for the purpose of playing an interactive game.

28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Okada with the combined game system of portable game devices and game console as described by Tomizawa, for the purpose of playing an interactive game with both common and discrete displays.

29. Accordingly, claims 4-6 , 8 and 11-15 would have at least been obvious.

30. As to claims 9 and 10, Okada in view of Tomizawa includes software that supports a contest (interactive game) among multiple player, but fails to explicitly disclose that the contest is adjudicated at either one of the elements or at a server. Tomizawa discloses however (column 12, lines 43-44), "At end of a game, name of a winner, score of each player, and the like may be displayed." One of ordinary skill in the art would recognize that this is merely a design preference of the applicant, and further, that some form of adjudication (i.e. scoring, points, winner, etc.) is common in an overwhelmingly large majority of software-based gaming. Furthermore, whether the game score is displayed instantly, or the nature of the game permits multiple round scoring—i.e. aggregate scoring, where the score is stored in memory is merely a design preference, and would be obvious to one of ordinary skill in the art.

31. Accordingly, claims 9 and 10 would have at least been obvious.

32. **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Tomizawa, and further in view of Sawano.**

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33. The teachings of Okada in view of Tomizawa have been discussed above.

Okada in view of Tomizawa fails to specifically teach a system, where the communication link is capable of supporting a dynamic replacement or update of at least one software element.

34. Sawano discloses (column 2, lines 41-55), "...a game system according to an embodiment of the present invention communicatably connects a communications link between a portable game machine and another game machine. The portable game machine includes readable/writable storage capable of electrically reading/writing information. In response to turning on power, the portable game machine starts execution of a program stored in an information storage medium when the information storage medium is not loaded in the receiving portion but communication is possible to the other game machine over a communications link." It is well known in the art that most communication links support dynamic replacement or upgrades of software elements.

### ***Conclusion***

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tomizawa et al., US PUB 2002/0137566; Miyamoto et al., US PUB 2002/0165028; Okada et al., US PAT 5,095,798; and Ikeda et al, US PAT 6,371,854—as they all related to portable game systems which can be linked to other portable games systems, or to game consoles, for multiplayer gaming.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H. Bond whose telephone number is (571)-272-9760. The examiner can normally be reached on 8:30am - 5pm, M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tarifur Chowdhury can be reached on (571) 272-2287. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher H Bond  
Examiner  
Art Unit 3709

CHB

  
KIMBERLY D. NGUYEN  
PRIMARY EXAMINER